

REMARKS

Applicant requests reconsideration and allowance of the subject application. Claims 1-13 are pending. In the Office Action, the Examiner rejected claims 1-13 under 35 U.S.C. § 103, as allegedly not being patentable over U.S. Patent Application Publication No. 2002/0056079 by *Sato et al.* ("*Sato*") in view of U.S. Patent No. 6,571,112 to *Ramaswamy*. Applicant traverses this rejection for the reasons set forth below.¹

To support a rejection under Section 103(a), the Examiner must establish, *inter alia*, the applied references disclose each of the features recited in the claims. (See M.P.E.P. § 2142(a).) *Sato* and *Ramaswamy* fail in at least this regard.

Sato provides a method for loading an application program onto a reissued smart card. (*Sato*, abstract.) The Examiner concedes that *Sato* does not disclose or suggest "loading the second application part extracted from the application message from the terminal into the chip card according to the predetermined communication protocol under the control of the loading means," as recited in claim 1. (Office Action, p. 3) *Sato* also fails to teach other features of claim 1.

Sato says nothing about an "application including a *first part* intended for a terminal provided with an application management means and a *second part* intended for a chip card accepted in the terminal" (emphasis added), as recited in claim 1. The Examiner apparently believes the *Sato*'s application data stored in smart card application management database 110 corresponds to the "first part." (Office Action, p. 2.) However, the application data is merely "data related to the smart card" -- *it is not part of an application*. (*Sato*, ¶¶ 0103, 0121; FIGs. 14 & 17.) As shown in FIG. 1, *Sato*'s method loads an *entire* application onto a

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

reissued smart card 11 from a terminal 111. (*Id.* at ¶¶ 0080, 0086. 0080; FIG. 2; FIG. 8, step 808; & FIG. 11, step 1108.) Accordingly, *Sato* cannot be considered to disclose or suggest the claimed "application including a *first part* intended for a terminal provided with an application management means and a *second part* intended for a chip card accepted in the terminal." (Emphasis added.) Moreover, nowhere does *Sato* disclose that the application data is loaded into terminal 111 or smart card 11. Thus, *Sato* also fails to disclose or suggest "installing in the terminal the first application part," as recited in claim 1.

Ramaswamy does not overcome *Sato*'s many deficiencies. *Ramaswamy* relates to a method for processing an encapsulating message 104 including an embedded 510 message at a mobile station having a subscriber identity module (*Ramaswamy*, col. 1:44-59.) *Ramaswamy* determines whether or not to transfer the encapsulating message 104 to subscriber identity module 108 from mobile station 106. (*Id.* at col. 2:8-11.) That is, the *entire* encapsulating message 104 is either extracted in mobile device 106 or transferred to subscriber identity module 104. (*Id.*) *Ramaswamy*, therefore, does not disclose or suggest dividing encapsulating message 104 or embedded message 510 into more than one "part." Accordingly, *Ramaswamy* also fails to disclose or suggest an "application message containing the first application part and the second formatted application part," as recited in claim 1.

In addition, *Ramaswamy* does not disclose or suggest placing one part of encapsulating message 104 or embedded message 510 in mobile station 106 and another part in subscriber identity module 108. Accordingly, it cannot be considered to disclose or suggest "installing in the terminal the first application part extracted from the application message" and "loading the second application part extracted from the application message from the terminal into the chip card," as recited in claim 1.

Because both *Sato* and *Ramaswamy* fail to disclose or suggest an "application message containing the first application part and the second formatted application part," "installing in the terminal the first application part extracted from the application message" and "loading the second application part extracted from the application message from the terminal into the chip card," these documents, taken individually or in combination, cannot support a rejection of claim 1 under Section 103.

Furthermore, *Sato* and *Ramaswamy* do not describe "a loading means for loading the second application part in the chip card" or "formatting in the server the second application part so that it is compatible with a protocol for communication between the terminal and the chip card," as recited in claim 1. The Examiner cites *Sato*'s paragraphs 0076 to 0084 for allegedly disclosing these features. However, *Sato* appears to say nothing with regard to the claimed "loading means" or "formatting." *Ramaswamy* also appears to be silent with regard to these features and the Examiner does not rely on *Ramaswamy* for such disclosure. Accordingly, the purported combination of *Sato* and *Ramaswamy* fail to disclose or suggest these features as well.

Because *Sato* and *Ramaswamy* fail to disclose or suggest the above-identified features of claim 1, the references, whether taken individually or in combination, cannot support a rejection of claim 1 under 35 U.S.C. § 103(a). Claim 1 is, therefore, allowable over *Sato* and *Ramaswamy*. Claims 2-10 are also allowable over the applied references at least due to their dependence from claim 1.

Claims 11-13, although of different scope than claim 1, recite features similar to those recited in claim 1. Thus, claims 11-13 are allowable over *Sato* and *Ramaswamy* for similar reasons to those set forth above with regard to claim 1.

Conclusion

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims.

If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By: /Steven Ashburn/
Steven L. Ashburn
Registration No. 56,636

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620

Customer No. 21839